

REMARKS

In the Office Action dated October 6, 2006, claims 1, 3-8, 10, 12-16 and 18-23 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Furthermore, claims 1, 3-8, 10, 12-16 and 18-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. US 6,285,398 (“Shinsky et al.”) in view of U.S. Patent Application No. US 2004/0169767 A1 (“Norita et al.”).

With respect to the Section 112 rejections, Applicant has amended the independent claims 1, 10 and 18 to delete the limitation containing the phrase “*without user intervention*” although Applicant strongly disagrees with the assertion made in the Office Action. Thus, Applicant respectfully requests that the Section 112 rejections be withdrawn.

With respect to the Section 103(a) rejections, Applicant respectfully asserts that the Office Action has failed to establish a *prima facie* case of obviousness for the amended independent claims 1, 10 and 18, as explained below. In particular, the cited references of Shinsky et al. and Norita et al. when combined do not teach or suggest all the claim limitations of the amended independent claims 1, 10 and 18. Furthermore, there is no valid teaching or suggestion to combine the teachings of the cited references of Shinsky et al. and Norita et al. in the manner suggested by the Office Action to derive the claimed invention, as recited in the amended independent claims 1, 10 and 18. In view of the following remarks, Applicant respectfully asserts that the amended independent claims 1, 10 and 18, as well as the dependent claims 3-8, 12-16 and 18-21, are not obvious over Shinsky et al. in view of Norita et al., and requests that these claims be allowed.

In addition to amending the independent claims 1, 10 and 18, Applicant has canceled claims 22 and 23, and added new dependent claims 24-26. As explained below, these dependent claims 24-26 include subject matter not disclosed in the cited references. Thus, Applicant respectfully requests that these new claims 24-26 be allowed as well.

I. Patentability of Amended Independent Claims 1, 10 and 18

The Office Action has rejected the independent claims 1, 10 and 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over Shinsky et al. in view of Norita et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for these claims 1, 10 and 18. As such, Applicant respectfully requests that the independent claims 1, 10 and 18 be allowed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Cited references of Shinsky et al. and Norita et al. when combined do not teach or suggest all the claim limitations

The cited references of Shinsky et al. and Norita et al. when combined do not teach or suggest all the claim limitations of the amended independent claims 1, 10 and 18. As admitted in the Office Action on page 8 with respect to the independent claim 1, the cited reference of Shinsky et al. "fails to distinctly state that first and second images having different image capturing parameters are displayed for user selection." However, the Office Action on page 8 asserts that the cited reference of Norita et al. discloses the claimed limitation of "*displaying the first and second images as comparison images for user selection.*" Applicant respectfully disagrees with the above analysis.

As correctly stated in the Office Action on page 8, the cited reference of Norita et al. does disclose displaying first and second images. In particular, the cited reference of Norita et al. does disclose "an image sensor (9) that captures a plurality

of images at different exposure times by activating after a lapse of time (Ti) and replacing the previous image signal in a buffer memory (82) with the current image signal (page 6, paragraphs 115-118).” However, these captured images described in Norita et al. are not equivalent to the claimed “*first and second images*,” as recited in the amended independent claim 1.

The “*first image*” is recited in the amended independent claim 1 as being captured by “*processing raw image data of a single image of a captured scene of interest using a first setting of a selected image-capturing parameter*.” The “*second image*” is recited in the amended independent claim 1 as being captured by “*processing the raw image data using a second setting of the selected image-capturing parameter*.” Thus, the claimed “*first and second images*” are derived from the same “*raw image data of a single image*.”

In contrast, the captured images described in Norita et al. are derived from different raw image data since the images are captured at different exposure times. Thus, the cited reference of Norita et al. does not disclose “*displaying the first and second images as comparison images for user selection*” where the “*first image*” is captured by “*processing raw image data of a single image of a captured scene of interest using a first setting of a selected image-capturing parameter*” and the “*second image*” is captured by “*processing the raw image data using a second setting of the selected image-capturing parameter*,” as recited in the amended independent claim 1. Thus, the cited references of Shinsky et al. and Norita et al. when combined do not teach or suggest all the claim limitations of the amended independent claim 1.

B. There is no valid suggestion or motivation to combine the teachings of the cited reference of Shinsky et al. and Norita et al.

There is no valid teaching or suggestion to combine the teachings of the cited references of Shinsky et al. and Norita et al. in the manner suggested by the Office Action to derive the claimed invention, as recited in the amended independent claims 1, 10 and 18. The latest Office Action asserts on page 9 that “it would have been obvious for one skilled in the art to have been motivated to include the concept of adjusting the [current] settings of image capturing parameters according to a

displayed image that is selected by a user as disclosed by Norita in the method of processing raw image data by setting image capturing parameters using a graphical user interface as disclosed by Shinsky.” The alleged motivation for this modification is that “[d]oing so would provide a means for specifying an image having proper image capturing parameters while viewing a serially updated image in order to set the image capturing parameters (Norita: page 7, paragraph 135).”

The above assertion may provide a motivation to modify a digital still camera that continually captures updated images with the teachings of Norita et al. but not for a video camera, such as the video camera of Shinsky et al. The cited reference of Norita et al. discloses a digital camera that can sequentially capture a plurality of image signals corresponding to a plurality of exposure times with respect to a substantially same scene when the camera is switched to a multiple exposure mode. As described in paragraph [0119] of Norita et al., the captured images corresponding to a plurality of predetermined exposure times are sequentially displayed with increased exposure by a predetermined time interval with a lapse of time.

Such a process for capturing image signals using different exposure times for a substantially same scene DOES NOT make sense with respect to video cameras, such as the video camera of Shinsky et al. A video camera needs to capture tens of images per second to produce a smooth video. Thus, displaying captured images corresponding to a plurality of predetermined exposure times by a predetermined time interval with a lapse of time for user selection, as described in paragraph [0119] of Norita et al., is not practical, if not impossible, using a video camera. Furthermore, in the same paragraph [0135] of Norita et al. where the alleged motivation can be found, Norita et al. states that the multiple exposure mode “is suitable for photo shooting requiring a long exposure time, e.g., for capturing a night view or celestial objects,” which is obviously not appropriate using a video camera.

As stated in column 10, lines 59-65, the video camera of Shinsky et al. does have a high resolution still image mode. However, the video camera of Shinsky et al. in this high resolution still image mode is not described as capturing updated images with respect to an image-capturing parameter as is the case for the digital camera of Norita et al. with respect to exposure time. Thus, even when used in the high

resolution still image mode, one of ordinary skill in the art would not have been motivated to modify the video camera of Shinsky et al. with the teachings of Norita et al. As such, Applicant respectfully asserts that the independent claim 1 is not obvious in view of Shinsky et al. and Norita et al.

The amended independent claims 10 and 18 recite limitations that are similar to those of the amended independent claim 1. Therefore, the above remarks with respect to the independent claim 1 are also applicable to the amended independent claims 10 and 18. As such, Applicant respectfully asserts that the amended independent claims 10 and 18 are also not obvious in view of Shinsky et al. and Norita et al.

II. Patentability of New Dependent Claims 24-26

The new dependent claim 24 recites “*wherein the processing the raw image data using the second setting of the selected image-capturing parameter includes generating a simulated image that represents an image captured using the second setting of the selected image-capturing parameter to produce said second image.*” The cited references of Shinsky et al. and Norita et al. do not disclose “*generating a simulated image,*” as recited in the new dependent claim 24. Thus, the new dependent claim 24 is not obvious in view of the cited references of Shinsky et al. and Norita et al.

The new dependent claims 25 and 26 recite limitations that are similar to the limitations of the new dependent claim 24. Therefore, the new dependent claims 25 and 26 are also not obvious in view of the cited references of Shinsky et al. and Norita et al.

III. Patentability of Dependent Claims 3-8, 12-16 and 19-21

Each of the dependent claims 3-8, 12-16 and 19-21 depends on one of the amended independent claims 1, 10 and 18. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that

these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicant respectfully requests reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,
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